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EXAMINER

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ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/729,485
Filing Date: December 05, 2003
Appellant(s): WYNGAARD, CYNTHIA L.

MAILED
MAR 22 2007
GROUP 3700

Randall W. Fieldhack
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12 December 2006 appealing from the Office action mailed 26 July 2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2002/0151862 A1	Jitoe <i>et al.</i>	10-2002
US 5,713,884 A	Osborn, III <i>et al.</i>	2-1998

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(9) Grounds of Rejection

Claim Rejections – 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-5, 8, 11, 16-19 and 26-28 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Jitoe *et al.* (US 2002/0151862 A1; hereinafter “Jitoe”).

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Regarding claims 1 and 26, Jitoe teaches an absorbent article (1) defining a front waist region (6), a back waist region (7), a crotch region (8) that extends between and connects said front and back waist regions (6, 7), a longitudinal direction and a lateral direction, an inner surface, an outer surface opposite said inner surface, and a pair of longitudinally opposed end margins and a pair of laterally opposed side margins, said article (1) comprising:

A stretchable outer cover (3);

A stretchable bodyside liner (2) joined to the stretchable outer cover (3) in a superposed relation wherein said outer cover (3) and said bodyside liner (2) are joined (9, 13, 25) along at least a portion of each of said end margins to provide a front waist seam and a back waist seam and wherein said outer cover (3) and said bodyside liner (2) are joined (9, 13, 25) along at least a portion of each of said side margins in said front waist region (6) and said back waist region (7) to provide a pair of side seams in each of said front waist region (6) and said back waist region (7);

An absorbent body (4) disposed between said outer cover (3) and said bodyside liner (2), said absorbent body (4) defining a pair of longitudinally opposed absorbent end edges (22) and a pair of laterally opposed absorbent side edges (23);

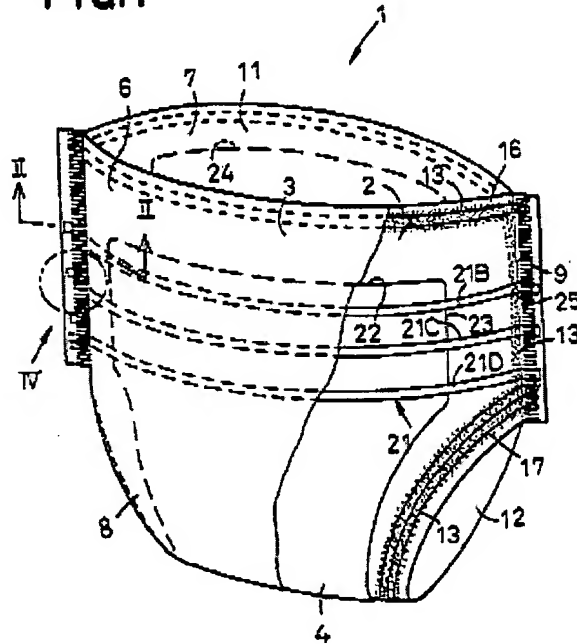
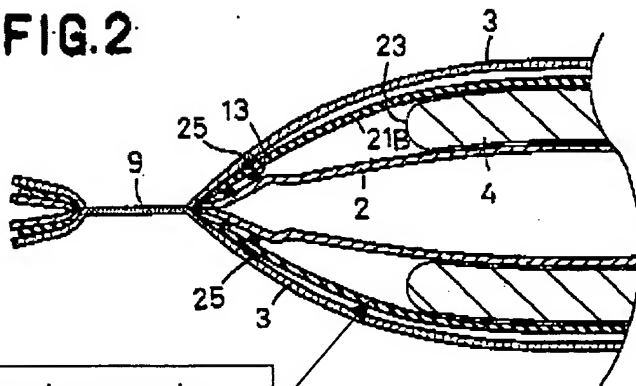
A first left elastomeric suspension member (21) disposed only in said front waist region (6) and attached to said absorbent body (4) in said front waist region (6); and

A second right elastomeric suspension member (21) attached to said absorbent body (4) in said back waist region (7);

Wherein said first elastomeric suspension member (21) is sandwiched between said outer cover (3) and said bodyside liner (2) in said pair of side seams in said front waist region (6), and

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wherein said second elastomeric suspension member (21) is sandwiched between said outer cover (3) and said bodyside liner (2) in said pair of side seams in said back waist region (7)(paragraphs 0026-0029)(see annotated figures 1 and 2, infra).

FIG. 1**FIG. 2**

2nd elastomeric suspension member

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Regarding the recited stretchability of the outer cover and body side liner, these layers are interpreted herein as being inherently stretchable because they are constructed of thermoplastics which are inherently stretchable or deformable to some degree, especially when heat is applied.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. §§ 102 and 103, expressed as a 102/103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. § 103 and for anticipation under 35 U.S.C. § 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. § 102/103 rejection is appropriate for these types of claims as well as for composition claims.

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, supra.

There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003).

“[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. § 102, on prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, supra). MPEP § 2112.

Regarding claims 16, 18 and 27, Jitoe teaches that the absorbent body (4) is configured to float between the outer cover (3) and the bodyside liner (2)(see figure 2, supra).

Regarding claim 2, Jitoe teaches that the first suspension member (21) defines a first suspension member width in said lateral direction that is substantially equal to an article width in said front waist region (6) and said second suspension member (21) defines a second suspension member width in said lateral direction that is substantially equal to an article width in said back waist region (7)(figure 1).

Regarding claims 3, Jitoe teaches that said first suspension member (21) is sandwiched between said outer cover (3) and said bodyside liner (2) in said front waist seam (figure 1).

Regarding claims 4, Jitoe teaches that said second suspension member (21) is sandwiched between said outer cover (3) and said bodyside liner (2) in said rear waist seam (figure 1).

Regarding claims 5, 19 and 28, Jitoe teaches that the suspension members (21) are constructed of materials that are inherently biaxially stretchable (paragraph 0032).

Regarding claim 8, Jitoe teaches that a portion of each of the suspension members (21) are longitudinally aligned with part of the absorbent member (4)(figure 1).

Regarding claim 11, Jitoe teaches an absorbent body that is hourglass-shaped (figure 1).

Regarding claim 17, Jitoe teaches that the absorbent body (4) is disposed toward the inner surface relative to the suspension members (figure 2).

Claim Rejections – 35 USC § 103

Claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 33 are rejected under 35 U.S.C. § 103(a) as obvious over Jitoe.

Jitoe is silent as to the specific elongatability of the suspension members, outer cover or bodyside liner. As discussed supra, the materials disclosed in Jitoe are inherently elongatable thermoplastics.

Differences in functional test or performance test characteristics will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such test characteristic is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Regarding claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 33, the benefits of optimizing the elongatability of the suspenders or other layers would have been known prior to applying a test, making these values result-effective variables. One of ordinary skill in the art would have

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recognized that increasing elongatability increases the ability of the finished product to withstand stresses that may be encountered during use. MPEP § 2144.04.

Claims 9, 10, 12, 14, 21, 22, 24, 30 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jitoe as applied to claims 1-5, 8, 11, 16-19 and 26-28, above, and further in view of Osborn, III *et al.* (US 5,713,884 A; hereinafter "Osborn").

Jitoe does not expressly disclose elastic outer covers, bodyside liners or absorbent bodies.

Osborn teaches an absorbent article having elastic topsheets, backsheets and absorbent cores (col. 18, lines 15-49; col. 26, lines 35-50).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the elastic body liner and core of Osborn with the article of Jitoe in order to provide an article that will comfortably conform to the anatomy of a wearer.

(10) Response to Argument

Applicants assert that Jitoe does not disclose a first elastomeric suspension member that is attached to said absorbent body in the front waist region. This argument is not persuasive because the elastic suspension members (21) are directly pressed against the absorbent core (4) during use. (paragraph 0033)(See figure 2, *supra*). This may be reasonably interpreted as an attachment of the suspension members to the absorbent core. Additionally, Jitoe teaches that the absorbent core (4) may be bonded to the backsheet (3), which in turn may be bonded to the elastomeric suspension members (21) via bonds (13, 25), providing an indirect attachment of the elastomeric members (21) to the absorbent core (4) via the back sheet (paragraph 0040).

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Applicants are reminded that the claims are given their broadest reasonable interpretation.

MPEP § 2111.

Applicants assert that attach and join are not used by applicants to describe a situation where two items are simply positioned adjacent or near one another. This argument is not persuasive because Jitoe teaches elastomeric members (21) that are directly pressed against an absorbent (4) member as a result of elastic tension acting on the members (21)(paragraph 0033). Statements in the reference that indicate that the elastomeric members are not secured to the absorbent core do not preclude this interpretation. Furthermore, the elastomeric members (21) are indirectly attached to the absorbent core (4) via backsheet (3) and attachments (13, 25)(paragraph 0040).

Applicants assert that their specification teaches an absorbent body (44) remains attached to the central absorbent assembly (32) via the suspension members (100). This is an indirect attachment of the absorbent body to the central absorbent assembly. According to this usage of “attach”, Jitoe teaches an absorbent core (4) that is attached to elastomeric members (21) via backsheet (3) and bonds (13, 25).

(11) Related Proceedings

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Bogart



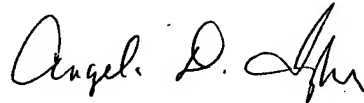
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